

Serial No. 10/728,269, filed 12/4/03

REMARKS

Claims 1-18 are presently pending in the application. Claims 1 and 9 are independent apparatus claims, and claim 12 is an independent method claim. Claim 6 is indicated as cancelled since it was missing from the originally presented claims.

A preliminary amendment was filed on March 4, 2004, shortly after the filing of this continuation application, in which amendments were made and new claims 16-18 were added. The Examiner's Restriction and Office Action Summary reference these new claims. However, the Examiner's Detailed Action clearly does not address any of these amendments, with the exception of the §103 rejection to claim 18. In particular, the Examiner does not even appear to recognize the amendments made to independent claims 1 and 12 and continues to recite the original language of these claims. In fact, the §102 rejection appears to be merely copied from the Examiner's Office Action in the parent application without any consideration to the amended language of the present claims. Accordingly, the Examiner's present Office Action is incomplete under MPEP 707.07, and a final rejection of claims in the next Office Action would be inappropriate under MPEP 706.07. Applicant respectfully requests a new non-final Office Action on the pending claims.

For example, amended claim 1 is allowable since Ballendux does not disclose a securing member and the associated language recited in claim 1. Amended claim 9 also recites a securing member. Similarly, the securing step of amended claim 12 is not disclosed in Ballendux.

§112 rejection

The Examiner has rejected claims 1-3, 5, 9, 10, 12, 14, 15 and 18 under §112 because, the Examiner believes, these claims are not enabled. The Examiner references the adjustment

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member 36 and bushing 50, however, bushing 50 is only recited in claim 18. Accordingly, the Examiner's rejection of claims other than claim 18 is unsupported. Whether a limitation or claim is enabled is determined from the perspective of one of ordinary skill in the art, not whether the limitations is discussed in great detail in the specification. Here, since an interference fit is provided between the adjustment member 36 and bushing 50, the adjustment member 36 can be moved in the bushing 50 between any number of longitudinal positions. Each longitudinal position would compress the spring to a varying degree, thus exerting a different detent force on the shift shaft. Clearly, this elementary concept is within the grasp of one of ordinary skill—one who is the designer of a complex manual transmission. Accordingly, claim 18—and every pending claim—is enabled.

§103 rejections

Claim 18 was rejected under §103 over Ballendux in view of either Butcher or Holmes. Since the Examiner stated the identical reasoning under both combinations, the rejections will be addressed together.

The Examiner cites two reasons as to why claim 18 is obvious. First, the Examiner argues that the claimed bushing “creates a simpler cheaper construction.” Second, the Examiner argues that “it well known that a bushing type interference fit is interchangeable with a threaded fastener.” These arguments on their face are insufficient to support the rejection. First, adding additional components to the arrangement of Ballendux creates a more complicated, more expensive arrangement by the mere presence of additional components. Further, whether interference fits with bushings and threaded fasteners is well known is not established by the Examiner. Moreover, even if it was, something being well known does not in of itself support a

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prima facie case of obviousness, as articulated in the MPEP. Rather, the Examiner must establish that one of ordinary skill in the art would be motivated modify Ballendux. There is no teaching in any of the cited references that would motivate one of ordinary skill to modify the arrangement of Ballendux to include a bushing.

With regard to Buchter, the interference fit is between the bushing and the housing, as best shown in Figure 5. It is not apparent how the bushing 64 would be used in the arrangement of Ballendux moreover, as stated above, there is no motivation or teaching in any of the references to even use a bushing in Ballendux.

In fact, the "bushing" 148 of Holmes is actually a snap ring, which is used to axially retain members. Further, how would this be incorporated into the arrangement of Ballendux though?

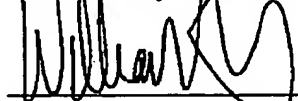
Accordingly, the rejection to claim 18 is improper and must be withdrawn. Homes clearly lacks a bushing, and the teachings of the references do not support a prima facie case of obviousness since there is no reason that one of ordinary skill would modify Ballendux.

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It is believed that this application is in condition for allowance. Please charge \$450.00 for a two-month extension to Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds. If any fees or extensions of time are required, please charge to Deposit Account No. 50-1482.

Respectfully submitted,

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Dated: _____

10/3/05